



13:34

5035703303

SAWSTOP LLC

PAGE 05/09

DA C#  
JW**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Date: February 2, 2006

STEPHEN F. GASS, ROBERT L. CHAMBERLAIN,  
J. DAVID FULMER, JOEL F. JENSEN and  
BENJAMIN B. SCHRAMM

Serial No.: 09/929,234

Examiner Ghassem Alie

Filed: August 13, 2001

Group Art Unit 3724

For: MOTION DETECTING SYSTEM FOR USE IN A SAFETY SYSTEM  
FOR POWER EQUIPMENT

To: Commissioner for Patents  
Group Art Unit 3724  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.704(B)**

Applicant requests reconsideration of the patent term adjustment indicated in the notice of allowance pursuant to 37 CFR 1.705(b).

**1. Fee Set Forth in 1.18(e).**

An authorization to charge a credit card for the \$200 fee set forth in 37 CFR 1.18(e) is attached.

**2. Statement of Facts Involved.****(i) The Correct Patent Term Adjustment and Bases for the Adjustment.**

The patent term adjustment indicated in the notice of allowance included a USPTO Delay of 275 days and an Applicant Delay of 359 days, for a patent term adjustment of 0 days, as shown on the Patent Application Information Retrieval (PAIR) web site (<http://pair.uspto.gov>). The correct patent term adjustment should include a

Page 1 - APPLICATION FOR PATENT TERM ADJUSTMENT  
Serial No. 09/929,234

USPTO Delay of 450 days and an Applicant Delay of 163 days, which results in a patent term adjustment of 287 days. This is explained below.

On August 2, 2004, applicant submitted a reply that the examiner said was non-responsive under 37 CFR 1.111. The Examiner said the reply was non-responsive because: "It appears that claim one includes multiple periods and therefore, claim 1 is confusing as to what the applicant has intended to be the full scope of the claim." (Office action mailed 1/12/2005, p.2.) The Examiner, however, was mistaken; claim 1 did not include multiple periods. Applicant pointed this out by re-submitting the reply on February 14, 2005 with the following explanation:

The Examiner stated that claim 1 includes multiple periods, and he requested that applicant correct the claim to avoid any confusion. Applicant has reviewed claim 1 but does not see multiple periods. The preamble to claim one ends in a colon, and the next four clauses all end with semicolons. The last clause ends with a period, and this is the only period in the claim. The confusion may stem from the fact that applicant submitted the second amendment via fax and perhaps the fax was unclear, causing the semicolons to appear as periods. In any event, claim 1 is reproduced above and applicant believes this response clarifies the issue. (Response to Office Communication dated February 14, 2005, p. 8.)

The re-submitted reply was accepted as responsive and prosecution of the application continued. Nevertheless, 196 days passed between August 2, 2004 and February 14, 2005, and those 196 days have been designated as Applicant Delay under 37 CFR 1.704(c)(7). The designation of those 196 days as Applicant Delay is incorrect because the August 2 reply was responsive. In other words, the August 2 reply did not include an omission as required to invoke 37 CFR 1.704(c)(7). Accordingly, the Applicant Delay of 359 days should be reduced by 196 days, resulting in a total delay of 163 days.

The USPTO Delay should be increased under 35 USC 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2) by 175 days because the Patent Office did not issue an action under 35 USC 132 within 4 months after applicant's August 2 reply. The next action under 35 USC 132 issued by the Patent Office after the August 2 reply was a non-final rejection mailed on May 26, 2005. That is 4 months and 175 days after August 2, 2004. Thus, the USPTO Delay should be corrected to include the current 275 days plus the additional 175 days for a total of 450 days.

The Patent Office mailed a notice of informal or non-responsive amendment on January 12, 2005, in which the Examiner said applicant's August 2 reply was non-responsive. That notice, however, did not constitute an action under 35 USC 132 because it did not reject the claims or make any legitimate objection or requirement, as required by the statute. The Examiner's request to correct the occurrence of multiple periods in claim 1 was not a legitimate or bona fide objection or requirement because there were no multiple periods in the claim. The Examiner was simply mistaken on that point, and that mistake delayed the prosecution of the application. The patent term should now be adjusted to correct the delay resulting from that mistake. Any other conclusion would unjustly deprive applicant of patent term and unfairly assign the consequences of the mistake to applicant. See, e.g., Application of Hayashibara, 525 F.2d 1062, 1065 n.3, 188 USPQ 4 (CCPA 1975) ("35 U.S.C. §132 requires that the Commissioner state grounds of rejection with sufficient clarity that applicants will be able to decide what to do next"); Application of Ludtke, 441 F.2d 660, 662 (CCPA 1971) (procedural due process and 35 U.S.C. 132 require adequate notice to applicants of reasons for rejections); Application of Ornitz, 376 F.2d 330, 332 (CCPA 1967)

(ambiguity in an opinion from the Board of Appeals should not be held against applicant in light of 35 USC 132).

Additionally, 37 CFR 1.104(a) requires an examiner to "make a thorough study" of an application to insure it complies both "with the applicable statutes and rules" and with "matters of form." If a "thorough study" is not done, then it is doubtful whether a subsequent rejection, objection or other requirement could satisfy 35 USC 132. In the case at hand, a thorough study apparently was not conducted with respect to claim 1 at the time of the January 12 notice. If it had been, then it would have been apparent that claim 1 did not include multiple periods. The lack of a thorough study of claim 1 prior to the mailing of the January 12 notice is another reason why the notice does not constitute an action under 35 USC 132.

(ii) The Relevant Dates and Adjustment Specified in §1.703(f).

As explained above, the relevant date to reduce the Applicant Delay is August 2, 2004, the date applicant's response to a non-final action was filed. The relevant dates showing the USPTO Delay should be increased are the dates of August 2, 2004, when applicant's response was filed, and May 26, 2005, the date the Patent Office mailed a response under 35 USC 132.

The adjustment as specified in 37 CFR 1.703(f) to which the patent is entitled is:

	<u>Days</u>
USPTO Delay	450
Applicant Delay	163
Total PTA	287

(iii) Terminal Disclaimer.

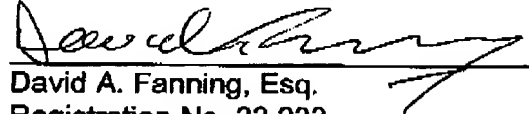
This application at hand is not subject to a terminal disclaimer.

(iv) Circumstances that Constitute a Failure to Engage in Reasonable Efforts to Conclude Examination.

The current PAIR calculation of patent term adjustment includes a failure to engage in reasonable efforts to conclude examination under 37 CFR 1.704(c)(7) for submission of a reply having an omission, as explained. Applicant disputes that calculation and asserts that there was no such delay.

Respectfully submitted,

SD3, LLC



David A. Fanning, Esq.

Registration No. 33,233

Customer No. 27630

25977 S.W. Canyon Creek Road, Suite G  
Wilsonville, Oregon 97070

Telephone: (503) 570-3200

Facsimile: (503) 570-3303

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop ISSUE FEE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the U.S. Patent Office to facsimile number (571) 273-2885 on February 2, 2006.

  
Renee Knight